



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/682,061

10/09/2003

Ilario Scuteri

CS20250P

8167

20280

7590

08/16/2004

MOTOROLA INC

600 NORTH US HIGHWAY 45

ROOM AS437

LIBERTYVILLE, IL 60048-5343

EXAMINER

TA, THO DAC

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                |  |
|------------------------------|-----------------|----------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)   |  |
|                              | 10/682,061      | SCUTERI ET AL. |  |
|                              | Examiner        | Art Unit       |  |
|                              | Tho D. Ta       | 2833           |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 22, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                                                                                                                                                                                     |                                                                                                                                                                                                                                                                                 |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/9/03</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input checked="" type="checkbox"/> Other: <u>Fig 3A of US 6,623,305 &amp; p.1 of US 6,471,550</u> |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 7, 8, 12-20, 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Chun-Lung (6,623,305).

In regard to claim 1, Chun-Lung discloses a multiple card holding apparatus, comprising: a first bracket (see attached drawing); a second bracket (see attached drawing) oriented in opposition to the first bracket; and a separation member (see attached drawing), disposed between the first bracket and the second bracket, forming a first holding region 206b and a second holding region 206a with the first bracket and the second bracket.

In regard to claim 2, Chun-Lung discloses that the first bracket includes a top portion (see attached drawing), a bottom portion (see attached drawing) and an intermediate portion (see attached drawing), interconnecting the top portion and the bottom portion, the second bracket includes a top portion, a bottom portion and an intermediate portion, interconnecting the top portion and the bottom portion, and

Art Unit: 2833

wherein the separation member is disposed between the intermediate portions of the first bracket and the second bracket.

In regard to claim 3, Chun-Lung discloses that the separation member has at least one opening 211 formed therein for providing the first holding region 206b with access to an electrical conductor 314e.

In regard to claim 4, Chun-Lung discloses that the first holding region 206b and the second holding region 206a are each capable of maintaining individual electronic elements 208b, 208a in a substantially vertically stacked manner relative to one another.

In regard to claim 5, Chun-Lung discloses that at least one contact member 312a-d and 212a-e in fig. 4B providing a spring bias force to couple the separation member to a base (PCB).

In regard to claim 7, Chun-Lung discloses that the first holding region 206b and the second holding region 206a are in line and commonly share the separation member therebetween.

In regard to claim 8, Chun-Lung discloses a multiple card holding apparatus, comprising: a first bracket structure including a top portion, a bottom portion and

Art Unit: 2833

an intermediate portion, interconnecting the top portion and the bottom portion;  
a second bracket structure including a top portion, a bottom portion  
and an intermediate portion interconnecting the top portion and the bottom portion;  
and a separation member, disposed between the intermediate portions of  
the first bracket structure and the second bracket structure, the separation member  
forming a first holding region 206b and a second holding region 206a with the first and  
second bracket structures (see attached drawing).

In regard to claim 12, Chun-Lung discloses that the first holding region 206b is  
configured to slidably engage a first electronic element 208b.

In regard to claim 13, Chun-Lung discloses that the second holding region 206a  
is configured to slidably engage a second electronic element 208a, and wherein the  
first and second electronic elements 208b, 208a are maintained in a vertically stacked  
manner relative to one another while maintained within the first and second holding  
regions 206b, 206a.

In regard to claim 14, Chun-Lung discloses that the first holding region 206b and  
the second holding region 206a are each capable of maintaining separate electronic  
elements 208b, 208a in a vertically stacked manner relative to one another.

In regard to claim 15, Chun-Lung discloses that means 312a-d and 212a-e in fig. 4B for fixedly engaging the separation member to a base connector (PCB).

In regard to claim 16, Chun-Lung discloses a mobile communication device (column 1, lines 8-10), comprising: a device controller (this is inherent since a PCB is disclose in column 4, lines 60-65); and a card holder 200 configured to include a first holding region 206b and a second holding region 206a, wherein the first holding region 206b and the second holding region 206a are each capable of maintaining individual electronic cards 208b and 208a in a vertically stacked manner relative to one another, with each electronic card in communication with the device controller (on the PCB).

In regard to claim 17, Chun-Lung discloses that the card holder 200 includes a first bracket, a second bracket oriented in opposition to the first bracket, and a separation member, disposed between the first bracket and the second bracket, wherein the separation member forms the first holding region 206b and the second holding region 206a with the first bracket and the second bracket (see attached drawing).

In regard to claim 18, Chun-Lung discloses the separation member has at least one opening 211 formed therein for providing the first holding region 206b with access to at least one electrical conductor 314e.

Art Unit: 2833

In regard to claim 19, Chun-Lung discloses that at least one first contact member 314e extending through the at least one opening 211 to provide an electrical connection for an electronic card 218b in the first holding region 206b.

In regard to claim 20, Chun-Lung discloses that a third contact member 214d to provide an electrical connection for an electronic card 281a in the second holding region 206a.

In regard to claim 23, Chun-Lung discloses that the at least one first contact member 314e and the at least one second contact member 214a comprise a plurality of conductors.

3. Claims 1, 2, 6, 8, 11, 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Maiterth et al. (6,471,550).

In regard to claim 1, Maiterth et al. discloses a multiple card holding apparatus 12, comprising: a first bracket (see attached drawing); a second bracket (see attached drawing) oriented in opposition to the first bracket; and a separation member 197, disposed between the first bracket and the second bracket, forming a first holding region 95 and a second holding region 96 with the first bracket and the second bracket.

In regard to claim 2, Maiterth et al. discloses that the first bracket includes a top portion (see attached drawing), a bottom portion (see attached drawing) and an

Art Unit: 2833

intermediate portion (see attached drawing), interconnecting the top portion and the bottom portion, the second bracket includes a top portion, a bottom portion and an intermediate portion, interconnecting the top portion and the bottom portion, and wherein the separation member is disposed between the intermediate portions of the first bracket and the second bracket.

In regard to claim 6, Maiterth et al. discloses that the bottom portion of the first and second brackets further include an attachment member 13 configured to engage a base connector 11, wherein the card holding apparatus 12 is rotationally positioned relative to a base (PCB).

In regard to claim 8, Maiterth et al. discloses a multiple card holding apparatus 12, comprising: a first bracket structure including a top portion, a bottom portion and an intermediate portion, interconnecting the top portion and the bottom portion; a second bracket structure including a top portion, a bottom portion and an intermediate portion interconnecting the top portion and the bottom portion; and a separation member 197, disposed between the intermediate portions of the first bracket structure and the second bracket structure, the separation member forming a first holding region 95 and a second holding region 96 with the first and second bracket structures (see attached drawing).

In regard to claim 11, Maiterth et al. discloses that the bottom portion of at least one of the first and second bracket structures includes an attachment member 13 configured to engage a base connector 11, wherein the card holding apparatus 12 is rotationally positioned relative to a base (PCB).

In regard to claim 16, Maiterth et al. discloses a mobile communication device (column 1, lines 8-10), comprising: a device controller (this is inherent since a PCB is disclose in column 4, lines 1-5); and a card holder 12 configured to include a first holding region 95 and a second holding region 96, wherein the first holding region 95 and the second holding region 96 are each capable of maintaining individual electronic cards 1 in a vertically stacked manner relative to one another, with each electronic card 1 in communication with the device controller (on the PCB).

In regard to claim 17, Maiterth et al. discloses that the card holder 12 includes a first bracket, a second bracket oriented in opposition to the first bracket, and a separation member, disposed between the first bracket and the second bracket, wherein the separation member forms the first holding region 95 and the second holding region 96 with the first bracket and the second bracket (see attached drawing).

In regard to claim 18, Maiterth et al. discloses the separation member has at least one opening 98 formed therein for providing the first holding region 95 with access to at least one electrical conductor (see figures 9 and 10).

In regard to claim 19, Maiterth et al. discloses that at least one first contact member extending through the at least one opening 98 to provide an electrical connection for an electronic card 1 in the first holding region 95 (see figures 9 and 10).

In regard to claim 20, Maiterth et al. discloses that a third contact member to provide an electrical connection for an electronic card 1 in the second holding region 96 (see figures 9 and 10).

In regard to claim 21, Maiterth et al. discloses that a housing and a circuit board carried in the housing, the device controller carried on the circuit board and the card holder 12 movably carried on the circuit board to move between an open position for insertion and removal of multiple cards 1 and an engaged position for operation of the device in electrical connection with multiple cards 1. Although Maiterth et al. does not specifically disclose the claimed device controller and the housing, these features are seen to be an inherent teaching of that device since a PCB and the card connectors are disclosed to be used in mobile telephone are disclosed in column 1, lines 5-10 and it is apparent that some type of housing and device controller must be present for the communication card to function as intended.

***Allowable Subject Matter***

4. Claims 9, 10, 22, 24, 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: In regard to claims 9, 24, the prior art fails to provide, teach or suggest at least one contact member coupled to the first and second bracket structures, operable to provide an electrical connection extending into the separation member; and in combination with all of the limitations of the base claim and any intervening claims. In regard to claim 22, the prior art fails to provide, teach or suggest at least one first contact member and the at least one second contact member connect to the circuit board on different sides of the card holder when the card holder is in the engaged position; and in combination with all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (571) 272-2014. The examiner can normally be reached on M-F (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 ext 33. The fax phone

Art Unit: 2833

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**THO D. TA**  
**PRIMARY EXAMINER**

tdt  
08/12/04